

REMARKS

Status of the Claims

Pending claims

Claims 31, 32, 36, 37, 44, 49, 50, 52 to 66, and 68 to 80, are pending.

Claims allowed

Applicants thank the Examiner for allowing claims 31, 32, 49 and 66.

Outstanding rejections

Claims 44, 50 and 66 to 80 are rejected under 35 U.S.C. §112, first paragraph, enablement requirement. Claims 36, 37, 50, 52 to 65, 69 and 70 are rejected under 35 U.S.C. §112, second paragraph. Applicants respectfully traverse all outstanding objections and rejections of the claims.

Support for the Claim Amendments

The specification sets forth an extensive description of the invention in the pending and amended claims. For example, support for claims directed to methods comprising use of polypeptide or nucleic acid sequences having various sequence identities at or above about 95%, 97%, 99% or more, to exemplary sequences of the invention can be found, inter alia, on page 11, lines 20 to 30; page 42, lines 5 to 23; or in paragraphs [0161], [0162], [0242] and [0243] of U.S. Patent Application publication no. 20020012974 (“the ‘974 publication”).

Accordingly, Applicants submit that no new matter has been introduced and the instant amendment can be properly entered.

Requesting entry of the amendments under 37 CFR §1.116

Applicants respectfully request entry of the amendments set forth in this response under 37 CFR §1.116. The amendment places the case in condition for allowance and places the case in better condition for appeal; the amendment does not raise any issues of new matter; and, the amended claims do not present new issues requiring further consideration or search.

Rejection Under 35 U.S.C. § 112, First Paragraph, enablement

Claims 44, 50 and 66 to 80 are rejected under 35 U.S.C. §112, first paragraph, enablement requirement, because the specification allegedly does not enable a person skilled in the art to which

the invention pertains or with which it is most nearly connected to make the invention commensurate in scope with the instant claims, as set forth in detail in paragraph 5, on pages 3 to 9, of the OA.

The Office acknowledges that the specification is enabling for a method of stereoselectively producing an alpha-substituted carboxylic acid having the structure recited in the claims (i.e., $C(R_1)(R_2)(E)(COOH)$, where R_1 , R_2 and E are defined in the claims, using a nitrilase consisting of the sequence of SEQ ID NO:2 or SEQ ID NO:4, or encoded by a nucleic acid of SEQ ID NO:1 or SEQ ID NO:3 (see lines 2 to 6, of paragraph 5, page 3, of the OA).

However, the Office remains concerned about the scope of the genus of polypeptides used in the claimed methods, in particular, the genus of polypeptides encompassing 90% or 85% sequence identity to the exemplary sequences (see, e.g., lines 6 to 20, of paragraph 5, page 3, of the OA).

While Applicants respectfully traverse, and aver that the specification enables the full scope of the pending claimed invention – for reasons set forth in detail in previous responses, all of which are expressly incorporated herein – only to expedite prosecution and allowance of this application, in this instant amendment Applicants have narrowed the scope of the genus of polypeptides used in the claimed methods. Thus, the instant amendment should sufficiently address this issue, and the rejection based on section 112, first paragraph, can be properly withdrawn.

Issues under 35 U.S.C. §112, second paragraph

Claims 36, 37, 44, 50, 52 to 65, 67 to 72, and 77 are rejected under 35 U.S.C. §112, second paragraph, as allegedly indefinite for reasons set forth in detail in paragraphs 6 to 8, on page 10, of the OA. The instant amendment addresses these issues.

CONCLUSION

In view of the foregoing amendment and remarks, Applicants respectfully aver that the Examiner can properly withdraw the rejection of the pending claims under 35 U.S.C. §112, first and second paragraphs. In view of the above, claims in this application after entry of the instant amendment are believed to be in condition for allowance. Accordingly, the Examiner is respectfully requested to withdraw the outstanding rejections of the claims and to pass this application to issue.

In the event the U.S. Patent and Trademark office determines that an extension and/or other relief is required, applicant petitions for any required relief including extensions of time and authorizes the Commissioner to charge the cost of such petitions and/or other fees due in connection with the filing of this document to **Deposit Account No. 03-1952** referencing docket No. 564462006600. However, the Commissioner is not authorized to charge the cost of the issue fee to the Deposit Account.

If it is determined that a telephone conference would expedite the prosecution of this application, the Examiner is invited to telephone the undersigned at the number given below.

Dated: June 29, 2007

Respectfully submitted,

By /Gregory P. Einhorn/
Gregory P. Einhorn
Registration No.: 38,440
MORRISON & FOERSTER LLP
12531 High Bluff Drive
Suite 100
San Diego, California 92130-2040
direct dial 858 720 5133
general office 858 720 5100
fax direct 858 523 5933
fax office 858 720 5125
email geinhorn@mofo.com